

Application No.: 10/700,929
Amendment dated: November 23, 2005
Reply to Office Action of August 23, 2005
Attorney Docket No.: 21295.70 [H5704US]

b.) Remarks

Claims 1-7 and 14-16 are pending in this application. Claims 1, 14 and 15 have been amended in various particulars as indicated hereinabove. Claims 8-13 and 17-23 are withdrawn from consideration. Claims 1-5, 7 and 14-16 are rejected. Claim 6 is objected to, but would be allowable.

Claims 1-3, 7 and 14-16 were rejected under 35 U.S.C. 103(a) over Finarov (US 5,604,344). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

Finarov describes transferring a pattern onto the object surface 16 (Col. 5, lines 1-4), then, if the object surface is not the object plane, passing "a defocused image of the defocused pattern 64 and the object through to the image plane 14 and to the CCD 70" (Col. 5, lines 33-34). In Finarov's autofocus apparatus 40, "as objective lens 10 moves closer to or further from the object surface 16, the image of pattern 64 will get significantly less or more blurry." (Col. 5, lines 39-41) The sharpness of an image is determined based on the sharpness of the pattern. "When the object surface 16 moves, the CCD 70 receives a blurred image of the object. In contrast, the image of the pattern is fixed and does not move with respect to the objective lens 10 and the CCD detector 70. Thus, the image of the pattern will strongly contrast with that of the object and the sharpness of the pattern can be determined." (Col .5, lines 65-67, Col. 6, lines 1-3).

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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In contrast, the present invention as claimed in amended independent Claim 1, is directed to investigating a tissue layer in a living animal, in particular, by sensing positional changes of the tissue layer caused by movements of the animal or an organ inside the animal, further generating signals corresponding to the positional changes, and processing or evaluating the signals based on the sensed positional changes. Col. 5, lines 20-22, of Finarov does not disclose sensing the changes in a position of the tissues and further analyzing the signals corresponding to the positional changes to obtain a focused image of the layer. Finarov says (Col. 5, lines 18-20) that “if the object moves, which causes the object to appear blurry, the pattern 64, which does not move, will remain sharply visible”, which only describes that the object’s movements do not affect the sharpness of the pattern, the very characteristic used in Finarov’s apparatus for autofocusing. Finarov does not disclose the motion of the tissue layer in an animal, nor does Finarov disclose sensing the positional changes of the tissue layer caused by the motion of the tissue layer and processing the signals corresponding to the sensed positional changes of the tissue layer to obtain sharp images.

Therefore, amended independent Claim 1 is not obvious over Finarov. Applicants request that the 103(a) rejection be withdrawn and amended independent Claim 1 be allowed.

Claims 2-5 and 7 depend off now allowable Claim 1 and are allowable.

With regard to amended independent Claim 14, Applicants respectfully assert that similarly to the above-presented arguments, Finarov does not disclose the movement means for sensing positional changes caused by movements of the animal or animal’s organ, nor does Finarov disclose the electronic system for generating signals corresponding to the sensed positional changes. Finarov also does not disclose the memory for storing the signals corresponding to the sensed positional changes caused by the above-described movement.

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Therefore, amended independent Claim 14 is not obvious over Finarov.
Applicants request that the 103(a) rejection be withdrawn and amended independent Claim 14 be allowed.

Claims 15-16 depend off now allowable Claim 14 and are allowable.

Applicants believe that the present application is in condition for allowance.
Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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